REMARKS

In his Action, the Examiner rejected each of the elected pending claims (Claims 1 to 5 and 30) under 35 U.S.C. §103 as being unpatentable in view of the disclosures of Bruno et al., *Cancer Surveys*, 17: 305-313 (1993), (hereafter "Bruno et al.") and Urien et al., *Invest. New Drugs*, 14: 147-151 (1996), (hereafter "Urien et al.").

Applicant traverses the Examiner's rejection respectfully. To establish a *prima facie* case of obviousness, the following criteria must be met: (A) the combined references must teach or suggest all the claim limitations; and (B) there must be a reasonable expectation of success. MPEP §2143. As discussed below, the Examiner has not established a *prima facie* case of obviousness because the above criteria are not met.

The combined references do not teach or suggest all of the claim limitations of the rejected claims. Claims 1 to 5 and 30 are directed to a method for determining the dosage of a taxoid to administer to a patient being treated for cancer. Bruno et al. consists merely of a description of the pharmacokinetics and metabolism of docetaxel and describes a finding that the pharmacokinetic outcome of docetaxel treatment is independent of the dose and formulation thereof and, as an aside, states that there is some interpatient variability in this pharmacokinetic outcome. Urien et al. states that alpha-1-acid glycoprotein (AAG) binds docetaxel in the blood plasma and the level of AAG is the main determinant of docetaxel plasma binding variability. Nowhere in the combined disclosures of the above references is there a teaching of <u>any</u> method for determining the dosage of taxoid to administer to a patient being treated for cancer, let alone one with the specific steps recited in applicant's claims. Furthermore, the combined disclosures do not even suggest such a method. While the Examiner argues

that it was "obvious" for one of skill in the art to arrive at such a method, he has failed to support his views regarding how the art suggests such a method other than by re-stating the above findings of Bruno et al. and Urien et al. As far as those findings are concerned, it is only taught that the level of AAG in a patient is the main determinant of docetaxel plasma binding variability. The combined disclosures of the above references do not even hint that the level of AAG is a factor in determining the effectiveness of taxoid in the treatment of cancer. Urien et al. itself states, "[AAG] simultaneously influences the free serum fraction of docetaxel, and it is unclear whether the free drug concentration is actually changed. Therefore, the clinical significance of this finding remains unclear." Since applicant's claimed method recites that a determination of the dosage of taxoid to administer to a patient is to be based on the patient's AAG level, it is clear that the combined disclosures of the cited references do not suggest applicant's claimed method. Rather, by stating that applicant's claims were obvious in view of the cited references, the Examiner has engaged in impermissible hindsight reconstruction.

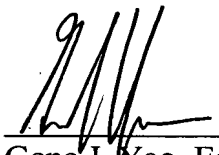
Independent of the above, it is also the case that one skilled in the art, even if he/she could had arrived at applicant's method from the disclosures of Bruno et al. and Urien et al., would not have had a reasonable expextation of success. It can not be inferred, based on the disclosure of: (A) Bruno et al.'s description of interpatient variability in the pharmacokinetic outcome of docetaxel treatment; and (B) Urien et al.'s statement that the level of AAG in a patient is a main determinant of docetaxel plasma binding variability, that the level of AAG would serve as a determinant of the effectiveness of taxoid in the treatment of cancer. This being the case, one skilled in the art would have no expectancy that applicant's claimed method would be proper for determining the dosage of taxoid to administer to a patient being treated for cancer.

Given the above, applicant notes respectfully that the Examiner has failed to establish a *prima facie* case of obviousness. Applicant traverses respectfully the Examiner's rejection and requests that the Examiner withdraw this rejection.

An early and favorable Action is requested.

This Reply is accompanied by a Petition for a one-month extension of time to respond to the Examiner's Action.

Respectfully submitted,



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